

REMARKS

The Final Office Action mailed December 13, 2007, has been received and reviewed. Claims 1 through 9, 11 through 74, 179 through 186, and 189 through 193 are currently pending in the application. Claim 191 stands rejected. Claims 1 through 9, 11 through 74, 179 through 186, 189, 190, 192 and 193 have been allowed and such allowance is noted with appreciation. Applicants amend claim 191, and respectfully request reconsideration of the application as amended herein.

35 U.S.C. § 102(a) Anticipation Rejections

Anticipation Rejection Based on McKay et al., “New Developments in the Technology of Drilling with Casing: Utilizing a Displaceable DrillShoe Tool,” World Oil Casing Drilling Technical Conference (March 6-7, 2003), Pages 1-11 (Paper No. WOCD-0306-05).

Claim 191 stands rejected under 35 U.S.C. § 102(a) as being anticipated by McKay et al., “New Developments in the Technology of Drilling with Casing: Utilizing a Displaceable DrillShoe Tool,” World Oil Casing Drilling Technical Conference (March 6-7, 2003), Pages 1-11 (WOCD-0306-05) (hereinafter (“Paper No. 1”). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As previously set forth in the Amendment filed on September 18, 2007, Applicants assert that Paper No. 1 does not inherently describe all the limitations of claim 191 as previously presented. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.

Cir. 1991); MPEP § 2131.01. Applicants respectfully assert that the Examiner has failed to identify any extrinsic evidence that makes clear the fact that the grooves behind and between the cutting elements on the blades of the bits shown in Figures 1 and 2 of Paper #1 would inherently cause the bit face to break into two or more smaller sections when the next drill bit drills through the first bit.

As there is no evidence that the grooves behind and between the cutting elements on the blades of the bits shown in Figures 1 and 2 of Paper #1 would inherently cause the bit face to break into two or more smaller sections when the next drill bit drills through the first bit, Paper #1 clearly cannot be considered to inherently describe at least one groove that is configured to cause at least one blade of a plurality of blades in which the groove is formed to separate into two or more smaller sections when another drilling tool is used to drill through the casing bit.

Nonetheless, in an effort to expedite allowance of the present case, Applicants amend independent claim 191 to further distinguish over Paper No. 1. Applicants respectfully assert that independent claim 191, as amended herein, is not anticipated by Paper No. 1 under 35 U.S.C. § 102(a) because Paper No. 1 does not describe a casing bit that includes “at least one groove formed in ... at least one blade of [a] plurality of blades, the at least one groove configured to cause the at least one blade to separate into two or more smaller sections when another drilling tool is used to drill through the casing bit, **the at least one groove comprising an end surface extending longitudinally into the at least one blade at a location rotationally behind the one or more cutting elements to a floor**, the at least one groove extending through the at least one blade to a rotationally trailing longitudinally extending surface of the at least one blade,” as recited in independent claim 191 as amended herein.

The grooves between the cutting elements on the blades of the of the bits shown in FIGS. 1 and 2 of Paper No. 1 extend from the rotationally leading surface of the blades to the rotationally trailing surface of the blades. The grooves do not include end surfaces that extend longitudinally into the blades at location rotationally behind the cutting elements to a floor, as recited in claim 191 as amended herein.

As Paper No. 1 does not describe each and every element set forth in claim 191, Applicants assert that claim 191 is not anticipated by Paper No. 1 and respectfully request that the Examiner withdraw the rejection of independent claim 191 under 35 U.S.C. § 102(a).

ENTRY OF AMENDMENTS

The amendment to claim 191 above should be entered by the Examiner because the amendment is supported by the as-filed specification and drawings and does not add any new matter to the application. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1 through 9, 11 through 74, 179 through 186, and 189 through 193 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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